



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,736	05/31/2000	Avner Shafrir	52817.000112	2786
909	7590	07/05/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			HAILU, TADESSE	
			ART UNIT	PAPER NUMBER
			2173	
DATE MAILED: 07/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,736

Applicant(s)

SHAFRIR ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the AMENDMENT entered on April 27, 2005 for the patent application number 09/583,736.
2. The present patent application claims priority from domestic US Application 60/137,513 filed April 2, 1999.
3. The pending claims 1-38 are examined as follows:

Response to the submitted Declaration Under 37 C.F.R § 1.131

4. The Declaration under 37 CFR 1.131 filed on April 27, 2005 has been considered but is ineffective to overcome the ICQ, i.e., ICQ Email Signature, published May 2, 1999 reference.

To begin with, the Declaration fails to disclose all the signatures of the named inventors of the pending application.

Furthermore, the Declaration submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the ICQ Email Signature reference. The Declaration must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms without submitting evidence (in the form of exhibits) along with a general assertion to reduce the invention to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established

Art Unit: 2173

by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Thus, the applicant fails to provide the facts that are sufficient to show reduction to practice to the invention prior to the effective date of the reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis LTD. Quick Tour. February 12 1998 in view of ICO Inc, 1CQ Email Signature, May 2 1999.

ICQ, as disclosed in Mirabilis LTD, Quick Tour, is an application that is used as a tool for communication. After installing this software application in a computer, ICQ allows you to know who is online (network), and allows you to contact them by clicking the name or the icon next to it and then send a message, initiate a chat session or launch any other interactive session (communication mode). ICQ automatically detects user connection to the Internet and announces your presence (on-line status indicator) to those whose list (contact list) you are on and notifies you if your contacts are on-line

Art Unit: 2173

(status indicator) as well. Thus status indicator is color-coded symbol (flower icon), i.e., it changes to green to announce your presence to those whose list you are on.

Furthermore, as described below, it is clear that the current claims are not distinguishable over the cited art.

With regard to claim 1:

Claim 1 recites, among other things, "communication selection means," ICQ, as described in Quick Tour, describes that users can launch any one of the communication modes selected from a user's menu; such as chat (in real time), e-mail, etc. The status indicator reflects the selected mode of communication (Quick Tour, pages 6-7).

As per "communication means," ICQ, as described in Quick Tour, allows you to contact other ICQ users on the Internet by clicking the name (identifier) or the icon next to it and then send a message, initiate a chat session (real-time) or launch any other interactive session (communication mode) (Quick Tour, pages 6-7);

As per "user indicator presentation means," ICQ, as described in Quick Tour, teaches user indicators, such as user's name, ICQ's unique ID number, etc that are associated with the user. As mentioned above when one of the indicators are selected, it allows you to establish a communication with other users (Quick Tour, pages 6-7). However, ICQ, as described and illustrated in Quick Tour, fails to teach "presenting one or more user indicators within the two or more types of electronic documents, wherein the electronic documents types are capable of being generated using two or more types of applications"

ICQ, in ICQ Email Signature, describes this shortcoming. ICQ, in ICQ Email Signature, explicitly describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., HTML user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the user indicator (signature) feature to the previous version of ICQ (How to Use ICQ) because it enhances the ICQ communication tool and at the same time this enhancement will benefit the users of both ICQ and non ICQ users as well.

With regard to claims 8, 15, 22, and 30-33:

The remaining independent claims, 8, 15, 22, 30-33 are rejected for the same reason given to claim 1. Claims 30 and 32 further call for a status indication module associated with a first system application and a communication selection module associated with a second system application, wherein, the first and second system applications are different system applications. ICQ, as describes in Quick Tour, also teaches the above limitations, wherein status can be associated with e-mail, chat or data conference applications that determines a status of a user associated with user indicator (Quick Tour, pages 5-6). Furthermore, ICQ does provide plurality of status determining indicators to know the status (online, offline, etc.) of one or more users on

the Internet (see page 2), wherein user's status can be associated with different applications.

With regard to claims 2, 10, 16, and 24:

As per claims 2, 10, 16, and 24, the ICQ user can control his/her availability to other users by choosing one of the many options; such as if the user does not want to be disturbed he clicks "Do not Disturb" option (Quick Tour, page 5). All other users receive this information as well and have a clear idea on the status.

With regard to claims 3, 11, 17, and 25:

As per claims 3, 11, 17, and 25, the ICQ further teaches that urgent communication request can be sent from other users and this overrides the previous "Do not Disturb" status will be replaced by "Occupied (Urgent Msgs)" (Quick Tour, page 5).

With regard to claims 4-7, 12-14, 18-21, and 26-29:

As per claims 4-7, 12-14, 18-21, 26-29, as mentioned above, the ICQ does provide several communication mode to a user. Such communication mode includes, among others, e-mail, chat, send message files and URLs, play games, draw on whiteboards, and communicating through voice while surfing the net (Quick Tour, pages 6-7). User can initiate or establish any one of the communication modes to communicate and share at least one application with one or more users (Quick Tour, pages 6-7).

With regard to claims 9 and 23:

As per claims 9 and 23, as described above, ICQ also describes selecting a user indicator to establish or launch a desired mode of communication with the selected user (Quick Tour, pages 6-7).

With regard to claims 34 and 36:

Furthermore, ICQ (Quick Tour & Email Signature) discloses the status indication of the plurality of communication modes comprises a plurality of status indicators that correspond to the plurality of communication modes (Quick Tour, pages 4-8). ICQ further describes the user has full control over the way his availability (communication mode) is presented to other users. ICQ users can notify other users what communication mode they are using or available, and the status indicator corresponds to the selected communication mode (Quick Tour, pages 4-8).

With regard to claims 35 and 37:

Furthermore, ICQ (Quick Tour & Email Signature) discloses activating at least one communication mode includes selecting at least one of the pluralities of status indicators to initiate activation (Quick Tour, pages 4-8). ICQ further describes selecting a recipient from contact list and communicating with the selected recipient based on the recipient availability (communication mode) selected (selected status) (Quick Tour, pages 4-8).

With regard to claim 38:

In addition to the limitations claimed in the above independent claims, the instant claim recites documents generated by the two or more applications (which is similar to Quick Tour in view of Email Signature e-mail document, chat document, web

document, etc, see Quick Tour), the claim further recites each document includes at least two user depictions associated with at least two network users (which is similar to Quick Tour in view of Email Signature users indicator icons, see Quick Tour, pages 4-8); claim 38 also recites an identification determining module that references the user directory to access at least two user indicators (which is similar to Quick Tour in view of Email Signature name, ICQ number or contact list , see Quick Tour, pages 4-8).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

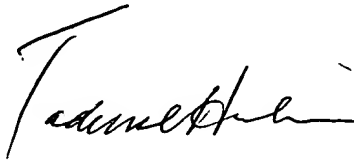
7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts

Art Unit: 2173

to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

8. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Patent Examiner
Tadesse Hailu
6/23/05

A handwritten signature in black ink, appearing to read 'Tadesse Hailu', is written over a light gray grid background.